

## **APPENDIX A**

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**TELEFAX COVER SHEET**

TO: Examiner Jeanette Chapman	FROM: Carla L. Gannon, Esq.
ORGANIZATION/FIRM: U.S. Patent and Trademark Office	DATE: June 15, 2009
FAX NUMBER: 571-273-8300	RECIPIENT'S PHONE NUMBER:
TOTAL # OF PAGES (Including Cover): 12	YOUR E-MAIL ADDRESS: cgannon@maccordmason.com
RE: ART UNIT 3633	

NOTES/COMMENTS:

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**MACCORD MASON PLLC**

**INTELLECTUAL PROPERTY PRACTICE**

# MEMO

**To:** Examiner Jeanette Chapman  
**From:** Carla L. Gannon  
**Date:** June 15, 2009  
**Re:** Interview on June 18, 2009, at 10:00am

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Dear Examiner Chapman;

In an effort to make our upcoming interview as productive as possible, we have prepared a proposed Response After Final and Request to Withdraw Final Office Action. It is enclosed.

We hope you will have an opportunity to consider our positions before the interview.

I look forward to speaking with you soon. As always, please feel free to contact me anytime directly at 336-543-3797 or [cgannon@maccordmason.com](mailto:cgannon@maccordmason.com).

Yours Sincerely,

Carla L. Gannon, Esq.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED  
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JUN 15 2009

In re Application of: Smith *et al.*

Serial No.: 10/786,466

Filed: February 25, 2004

Confirmation No. 9331

For: FIRE RESISTANT CONSTRUCTION

Examiner: J. Chapman

Art Unit: 3635

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

## **PROPOSED**

### **RESPONSE AFTER FINAL**

#### **AND REQUEST TO WITHDRAW FINAL OFFICE ACTION**

In response to the Office Action mailed March 17, 2009, please consider the offered Remarks and grant Applicants' request to reopen prosecution.

In the event an Extension of Time for the accompanying response is required, Applicants request that this be considered a Petition therefore. The Commissioner is hereby authorized to charge any additional fees that may be required to Deposit Account 501923.

Listing of Claims begin on page 2 of this paper.

Remarks begin on page 8 of this paper.

**Amendments to the Claims**

No claims are currently amended. This Listing of Claims reflects the current status of claims in the application:

**Listing of Claims**

1.(Previously Amended) A structure having a fire resistance rated, area separation wall, said structure comprising:

- (a) a first building unit;
- (b) a second building unit; and
- (c) an area separation wall rated for two hours at about 75% design load having only outer membranes and including a thermal insulation barrier between said outer membranes; said area separation wall further includes a tying structure having a double top plate assembly for connecting said fire resistance rated, area separation wall to said first unit and said second unit wherein one of the top plates is attached to the top edge of said area separation wall.

2.(Previously Amended) The structure according to Claim 1, wherein said double top plate assembly includes a pair of double top plates.

3.(Previously Amended) The structure according to Claim 2, wherein said tying structure includes a bottom plate attached to the bottom edge of said fire resistance rated, area separation wall.

4.(Cancelled)

5.(Previously Amended) The structure according to Claim 3, wherein one of said double top plates and said bottom plate are less than about 10 feet apart.

6.(Original) The structure according to Claim 1, wherein said first building unit is an occupiable space.

7.(Original) The structure according to Claim 6, wherein said occupiable space is residential.

8.(Original) The structure according to Claim 7, wherein said residential occupiable space is a town home.

9.(Original) The structure according to Claim 1, wherein said second building unit is an occupiable space.

10.(Original) The structure according to Claim 9, wherein said occupiable space is residential.

11.(Original) The structure according to Claim 10, wherein said residential occupiable space is a town home.

12.(Previously Amended) A two-hour fire resistance rated, area separation wall for a structure, said area separation wall comprising:

- (a) an interior support structure;
- (b) only an outer membrane on each side of said interior support structure;  
and
- (c) a substantially organic thermal insulation barrier between said outer membranes; said area separation wall rated for two hours at about 75% design load and further including a tying structure having a double top plate assembly for connecting said fire resistance rated, area separation wall to said first unit and said second unit wherein one of the top plates is attached to the top edge of said area separation wall.

13.(Original) The area separation wall according to Claim 12, wherein said interior support structure includes at least two structurally independent interior support members.

14.(Original) The area separation wall according to Claim 13, wherein said structurally independent interior support members include a plurality of vertical members.

15.(Original) The area separation wall according to Claim 14, wherein said plurality of vertical members are spaced apart.

16.(Original) The area separation wall according to Claim 15, wherein said plurality of vertical members are spaced apart no more than about 16 inches.

17.(Original) The area separation wall according to Claim 14, wherein said plurality of vertical members further include cross bracing at about the mid height of said plurality of vertical members.

18.(Original) The area separation wall according to Claim 13, further including a physical gap between said structurally independent interior support members.

19.(Original) The area separation wall according to Claim 12, wherein each of said outer membranes are fire resistant wallboard.

20.(Previously Amended) The area separation wall according to Claim 19, wherein said fire resistant wallboard is a gypsum wallboard (GWB).

21.(Previously Cancelled).

22.(Original) The area separation wall according to Claim 12, wherein said substantially organic thermal insulation barrier is selected from the group consisting of fibrous material, granular material, pellet material, aggregated material, agglomerated material and mixtures thereof.

23.(Original) The area separation wall according to Claim 12, wherein said substantially organic thermal insulation barrier is a natural material.

24.(Original) The area separation wall according to Claim 23, wherein said natural material is cellulosic.

25.(Original) The area separation wall according to Claim 12, wherein said substantially organic thermal insulation barrier is an acoustically non-conductive material.

26.(Previously Amended) A structure having a fire resistance rated, area separation wall, said structure comprising:

- (a) a first building unit;
- (b) a second building unit; and
- (c) an area separation wall rated for two hours at about 75% design load having only outer membranes, said area separation wall including: (i) an interior support structure; (ii) only an outer membrane on each side of said interior support structure; and (iii) a substantially organic thermal insulation barrier between said outer membranes; and
- (d) a tying structure having double top plate assembly for connecting said fire resistance rated, area separation wall to said first unit and said second unit wherein one of the top plates is attached to the top edge of said area separation wall.

27.(Previously Amended) The structure according to Claim 26, wherein said tying structure includes a bottom plate attached to the bottom edge of said fire resistance rated, area separation wall.

28.(Cancelled)



29.(Previously Amended) The structure according to Claim 27, wherein one of said double top plates and said bottom plate are less than about 10 feet apart.

30.(Original) The structure according to Claim 26, wherein said first building unit is an occupiable space.

31.(Original) The structure according to Claim 30, wherein said occupiable space is residential.

32.(Original) The structure according to Claim 31, wherein said residential occupiable space is a town home.

33.(Original) The structure according to Claim 26, wherein said second building unit is an occupiable space.

34.(Original) The structure according to Claim 33, wherein said occupiable space is residential.

35.(Original) The structure according to Claim 34, wherein said residential occupiable space is a town home.

36.(Original) The structure according to Claim 26, wherein said interior support structure includes at least two structurally independent interior support members.

37.(Original) The structure according to Claim 36, wherein said structurally independent interior support members include a plurality of vertical members.

38.(Original) The structure according to Claim 37, wherein said plurality of vertical members are spaced apart.

39.(Original) The structure according to Claim 38, wherein said plurality of vertical members are spaced apart no more than about 16 inches.

40.(Original) The structure according to Claim 37, wherein said plurality of vertical members further include cross bracing at about the mid height of said plurality of vertical members.

41.(Original) The structure according to Claim 39, further including a physical gap between said structurally independent interior support members.

42.(Original) The structure according to Claim 26, wherein each of said outer membranes is a fire resistant wallboard.

43.(Previously Amended) The structure according to Claim 42, wherein said fire resistant wallboard is a gypsum wallboard (GWB).

44.(Previously Cancelled).

45.(Original) The structure according to Claim 26, wherein said substantially organic thermal insulation barrier is selected from the group consisting of fibrous material, granular material, pellet material, aggregated material, agglomerated material and mixtures thereof.

46.(Original) The structure according to Claim 26, wherein said substantially organic thermal insulation barrier is a natural material.

47.(Original) The structure according to Claim 46, wherein said natural material is cellulosic.

48.(Original) The structure according to Claim 26, wherein said substantially organic thermal insulation barrier is an acoustically non-conductive material.

**Remarks**

The Office Action mailed March 17, 2009 has been carefully considered. No claims have been amended. Thus, Claims 1-3 and 5-11; 12-20 and 22-25; and 27, 29-43 and 45-48 remain in the case with none of the Claims currently being allowed.

As a preliminary matter, Attachment A in the December 4, 2008 Response (responding to June 6, 2008 Office Action) was submitted in error. Applicants intended to submit "Online Certifications Directory BXUV.U370, Fire Resistance Ratings – ANSI/UL 263", dated February 26, 2003, but instead submitted Online Certifications Directory BXUV.U370, Fire Resistance Ratings – ANSI/UL 263", dated November 6, 2006 (a revised version).

These documents are substantively similar, except for the dates. The former was previously submitted in the Information Disclosure Statement filed March 30, 2004. The latter is an updated version and is not prior art with respect to the February 25, 2004 filing date of the present case.

**I. Rejection of Claims 1, 12, and 26 Under 35 USC §112, ¶1**

Applicants disagree with the Office's position that "an area separation wall rated for two hours at about 75% design load" lacks antecedent basis in the original specification. As previously explained, the specification discusses the ANSI/UL 263 test<sup>1</sup>, which reports 75% of Design Load at 2 hours.<sup>2</sup>

Withdrawal of the rejection is respectfully requested.

<sup>1</sup> See page 1, lines 29-30.

<sup>2</sup> See page 2 of "Online Certifications Directory BXUV.U370, Fire Resistance Ratings – ANSI/UL 263", dated February 26, 2003.

**II. Rejection of Claims 1-3, 5-20, 22-27, 29-43 and 45-48 Under 35 USC §103(a)**

The Office appears to take the position that area separation walls rated for two hours at about 75% design load are known in the art because the same is disclosed in the "Online Certification Directory BXUV.U370, Fire Resistance Ratings ANSI/UL 263". However, this reference is not properly applied against the Applicants because it was neither:

- a) known or used by others before the applicants' invention; nor
- b) described in a printed publication more than one year prior to the date of the application.

Specifically, the testing reported in the "Online Certification Directory BXUV.U370, Fire Resistance Ratings ANSI/UL 263" report was commissioned by the assignee of the application to be performed on the inventors' invention. Accordingly, the "known or used by others" [emphasis added] requirement of 35 USC §102(a) has not been met.

Moreover, the "Online Certification Directory BXUV.U370, Fire Resistance Ratings ANSI/UL 263" does not qualify as a 35 USC §102(b) printed publication because the report is dated February 26, 2003, whereas the filing date of the present application is February 25, 2004, which is less than one year prior to the filing date of the present application.

In view of the inapplicability of "Online Certification Directory BXUV.U370, Fire Resistance Ratings ANSI/UL 263" as a reference, and the failure of Gebhardt, Mulford and ASTM E119-95a (the "Omega Reference") to teach area separation walls rated for two hours at about 75% design load, the Office has failed to establish prima facie obviousness.<sup>3</sup> Accordingly, withdrawal of the final rejection is respectfully requested.

<sup>3</sup> As discussed in the Response dated 12/4/08, Gebhardt does not appear to be suited for multi-level structures, and therefore does not inherently or explicitly teach 75% load bearing. Mulford walls are "slid into" building frames and do not appear to provide load bearing properties, let alone 75% load bearing. The Omega Reference does not teach 75% design load, it teaches 47.5% design load. Finally, as set forth in the previously offered Declarations of Stewart and Tambo, 2 hours at 75% are structurally and commercially critical.

**III. Request for Withdrawal of Final Office Action**

In view of "Online Certification Directory BXUV.U370, Fire Resistance Ratings ANSI/UL 253" being improperly applied, Applicants request the finality of the current Office Action be vacated, and prosecution reopened.

For at least the reasons discussed above, Applicants believe the Office's rejections have been addressed and overcome, and earnestly solicit allowance. However, if Applicants' attorney can assist in resolving any issue, the opportunity for a telephone interview would be welcomed.

Respectfully submitted,

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Date: June \_\_, 2009  
File No.: 8274-020